2) Attached is a new Information Disclosure Statement (IDS) and the $180.00 fee payment for the filing made after the first Office Action. Please carefully consider the related art supplied by Applicant in the IDS when reexamining all of the claims. Applicant realizes the previously submitted and attached Information Disclosure Statements are extensive and sincerely apologizes to the Examiner. The legal system regarding prior art disclosure, as presently determined by the courts, is a harsh master – expensive, time consuming and difficult – for an inventor who only wants to enjoy the fruit of his invention. Please examine the claims thoroughly so that Applicant may receive a valid and worthy Patent. Thank you for your time.

3) It is noted claims 1-7 and 11 are allowed, but it is requested they be reexamined in view of the new Information Disclosure Statement. Applicant believes those allowed 1-7 and 11 claims are still allowable.

4) Below, under Amendments, Applicant will amend the 35 U.S.C. 120 Priority claim originally made upon the application filing. This Priority claim amendment is to render the claim in compliance with the requirement of stating the relationship of the Child application to the Parent application, i.e., in this case "Continuation". Would the Examiner please enter the amendments and verify such is proper in format. Also please inform Applicant if anything else needs to be done in order for the Priority claim to made effective and printed on the front page of the Patent to issue from this Application. Thank you.

5)

AMENDMENTS TO THE SPECIFICATION AND PRIORITY CLAIM UNDER 35 USC 120

On page 1 of the Specification please amend the CROSS-REFERENCE TO RELATED APPLICATIONS section as follows wherein underlining indicates insertions and strikethrough indicates deletions:

~~A 35 USC 120 priority claim is hereby made to my pending~~ This Application is a Continuation of U.S. non-provisional application No. 09/167,314 filed 10/06/98, now U.S. Patent 6,198,473 to which a Priority claim is made under 35 U.S.C. 120.

~~_____(to be filled in later).~~

REMARKS

6) Further specifically regarding the 04/21/2004 Office Action:

On the Office Action Summary page it is noted that the Examiner is responding to Applicant's communication of 21, Jan. 2004.

It is noted that the 04/21/2004 Office Action is "non-final".

It is further noted claims 1-31 are pending in the application, and that claims 1-7, 11 are allowed and claims 8-10 and 12-31 are rejected.

7) Regarding the DETAILED ACTION starting on page 2 of the Office Action:

In point "1." on page 2 the Examiner states the amendment filed on 01/21/2004 is entered and the rejections of claims 8-10 and 12-31 are "maintained". Applicant respectfully points out that claim 31 was **newly** added in the 01/21/2004 amendment and was not previously rejected. In any case Applicant believes claim 31 should be allowed along with allowed claims 1-7 and 11. Please review claim 31 again in view of this, and find the claim allowable. Thank you. (More on the allowability of claim 31 is presented below)

8) Regarding point "2." of the DETAILED ACTION, it is noted the terminal disclaimer previously required by the Examiner is accepted. Applicant again states the terminal disclaimer is not an admission or agreement of obviousness by Applicant.

9) Regarding point "3." of the DETAILED ACTION, it is noted claims 8, 31 are rejected under 35 USC 102(b) as being anticipated by Levy US 5,367,631. Firstly regarding the rejection of claim 31, because it does not have dependent claims, in view of Levy '631: Levy does not include Applicant's claim 31 recited structural elements of

--said housing further supporting at least

one finger pressible element positioned to actuate at least

two pressure-sensitive variable sensors, output from said variable sensors variably controls scrolling within said display--.

Allowance of claim 31 is requested because Levy '631 fails to anticipate or suggest the claim 31 invention as indicated immediately above by the showing of entirely missing elements in claim 31 not in the Levy disclosure. Tilting the entire mouse housing as with Levy '631 is significantly different than variably pressing a finger pressible button on the housing to variably scroll within a display as in Applicant's claim 31. The Levy mouse does not have a pressure sensitive button operating a pressure sensor or two pressure-sensitive variable sensors as in the current invention of claim 31. Additionally, the Levy mouse requires the user to tilt the mouse in its entirety which might lead to wrist pain or the like, or might simply be less convenient or accurate than pressing a variably depressible button and leaving the housing stationary for scrolling within the display.

In Applicant's opinion "functional equivalent", as stated by the Examiner several times in the Office Action point "3.", is not present in the Levy '631 patent compared to claim 31.

The Examiner is reminded that the Manual of Patent Examining Procedure states: "MPEP 2131 Anticipation - Application of 35 U.S.C. 102(a), (b), and (e)",

"TO ANTICIPATE A CLAIM, THE REFERENCE MUST TEACH EVERY ELEMENT OF THE CLAIM "

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)."

"The identical invention must be shown in as complete detail as is contained in the ... claim." Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).." (end of quotes for MPEP 2131)

Withdrawal of the 35 USC 102(b) rejection of claim 31 is therefore requested and would be proper in accordance with the above quotes from the MPEP 2131. Allowance of claim 31 is requested over the Levy '631 patent. Thank you.

10) Regarding the rejection of claim 8 in view of Levy '631: Levy does not include Applicant's claim 8 recited elements of

--depressing, by a user, an analog scroll control button, located on said mouse, and controlling variable screen scrolling rate by way of selecting the pressure applied to said analog scroll control button--.

Levy in patent '631 does not include a depressible button to screen scroll using varying pressure to vary the rate of scrolling. Levy does not teach or suggest "depressing, by a user, an analog scroll control button, located on said mouse, and controlling variable screen scrolling rate by way of selecting the pressure applied to said

analog scroll control button". Therefore Levy cannot anticipate the invention of claim 8 under 35 USC 102(b). As stated above regarding claim 31 but now regarding Applicant's claim 8, tilting the entire mouse housing as with Levy '631 is significantly different than variably pressing a depressible button on the housing to variably window scroll as in Applicant's invention. The Levy mouse does not have a button operating a pressure sensor as in the current invention. Additionally, the Levy mouse requires the user to tilt the mouse housing which might lead to wrist pain (carpal tunnel) or might simply be less convenient or accurate than pressing a variably depressible button while leaving the mouse stationary.

The Examiner is again reminded that the Manual of Patent Examining Procedure states: "MPEP 2131 Anticipation - Application of 35 U.S.C. 102(a), (b), and (e)",

"TO ANTICIPATE A CLAIM, THE REFERENCE MUST TEACH EVERY ELEMENT OF THE CLAIM "

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "

"The identical invention must be shown in as complete detail as is contained in the ... claim." Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).." (end of quotes from 2131 MPEP)

Withdrawal of the 35 USC 102(b) rejection of claim 8 is therefore requested and would be proper in accordance with the above quotes from 2131 MPEP. Allowance of claim 8 is requested over the Levy '631 patent. Thank you.

11) Jumping ahead for the moment to address the 103 rejection of claim 9, claim 9 depends on claim 8 (allowable claim 8) and further includes increasing pressure on the button to increase scroll rate, plus the pointer is specifically stated as not required to be on a scrolling elevator, therefore claim 9 should be held allowable, and allowable in the very least because it depends upon an allowable base claim. Specifically regarding the 35 USC 103(a) rejection of the claim 9 of point "5." Of the Office Action: Neither Levy '631 or Adan et al '023 include a pressible button to operate a pressure sensor wherein varied pressure applied by the user on the button varies scrolling rate. Therefore the combination of Levy with Adan et al does not include those elements and therefore the combination of Levy with Adan et al cannot suggest those elements and further cannot suggest the claim 9 invention. Allowance of claim 9 is very respectfully requested.

12) Jumping ahead for the moment to address the 103 rejection of claim 10, claim 10 depends on claim 9 (allowable claim 9) and further includes decreasing pressure on the button to decrease scroll rate, therefore claim 10 should be held allowable, and allowable in the very least because it depends upon an allowable claim. Specifically regarding the 35 USC 103(a) rejection of the claim 10 of point "5." Of the Office Action: Neither Levy '631 or Adan et al '023 include a pressible button to operate a pressure sensor wherein varied pressure applied by the user on the button varies scrolling rate. Therefore the combination of Levy with Adan et al does not include those elements and therefore the combination of Levy with Adan et al cannot suggest those elements and further cannot suggest the claim 10 invention. Allowance of claim 10 is very respectfully requested.

Further regarding the obviousness rejections of claims 9 and 10, please see MPEP 2143.03 which has been provided below for the Examiner's reading convenience.

MPEP:

" 2143.03 All Claim Limitations Must Be Taught or Suggested

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)".

Again, claims 9 and 10 should be held allowable and such is respectfully requested. Thank you.

13) Regarding the point "4." on page 4 of the Office Action, the rejection of claims 12-30 under 35 USC 102(e) as being anticipated by Adan et al (US Patent Application Publication 2002/0054023):

In the Office Action of 09/25/2003 the Examiner relied upon Adan et al (US Patent Application Publication **2002/0036660**) filed on Dec. 3, 2001.

In the current Office Action the Examiner is now relying upon Adan et al (US Patent Application Publication **2002/0054023**) filed on Dec. 4, 2001.

In the Jan. 21, 2004 response from Applicant. Applicant requested he be provided a copy of the Patent Application 09/153,148 from which US Patent Application Publication 2002/0036660 was continued as a "Continuation". US Patent Application Publication 2002/0054023 is also said to be a "Continuation" of Application 09/153,148 and so the two published applications 2002/0036660 and 2002/0054023 should be, according to the Examiner, the same as one another and the same as parent application 09/153,148. Therefore, Applicant's questions as to why the Examiner now relies on application 2002/0054023 instead of application 2002/0036660? Is Applicant misunderstanding something regarding the Adan et al applications?

Also Applicant again respectfully requests a copy of Application 09/153,148 to read for himself. Application 09/153,148 is Abandoned and not readily available to Applicant. Furthermore, it is Applicant's understanding that secrecy of an unpublished application is surrendered when a later filed application makes a priority claim under 35 USC 120 to that unpublished application, here application 09/153,148. Is this surrender of secrecy to a parent application correct, and thus Applicant can have a copy of application 09/153,148? Please inform Applicant if he can legally obtain a copy of 09/153,148 from the PTO.

Applicant would like to read application 09/153,148 for himself before commenting on the allowability of his claims, canceling or amending claims 12-30 or swearing behind the reference. The Adan et al application 09/153,148 has an earlier filing date than published application 2002/0054023, thus published application 2002/0054023 must rely on that same data being in the parent application 09/153,148 because the filing date of

Applicant's instant application is effectively Oct. 6, 1998, the date of its parent application 09/167,314. (earlier than the filed date of published application 2002/0054023)

It is noted that published application 2002/0054023 is said to be a "Continuation" of parent application 09/153,148, but the "Continuation" status, i.e., the child having all of the same data as the parent application is normally not verified by the PTO until needed.

It is noted on page 6 of the current 04/21/2004 Office Action that the Examiner states the "Pub. No. US 2002/0054023 filed under 37 CFR 1.53 (b) It is a duplicate specification (exact copy) of the specification filed on parent case 09/153,148" .

It is not clear as to whether the Examiner has personally verified the two application specifications are exact copies of each other. Has the Examiner personally verified the two application specifications are exact copies or has the Examiner simply relied upon the status of "Continuation" as indicating the specifications are the same?

The Examiner is respectfully requested to personally verify the specifications are the same and state for the record he personally verified the specifications are exactly the same, or if at all possible provide a copy of parent application 09/153,148. Applicant would like a copy of application 09/153,148 if possible because this is a very important matter. Additionally, if the three Adan et al specifications are identical, i.e., the parent '149 and two children applications '660 and '023, Applicant is interested in knowing why the Examiner is relying now on a different child application than he did in the 09/25/2003 Office Action. Is Applicant misunderstanding something? Help from the Examiner would be deeply appreciated regarding this very important matter. Thank you.

14) Applicant, once sure of precisely what the prior art relied upon for a date earlier than Applicant's filing date actually states, will promptly make comments for allowance of claims 12-30 or will cancel or amend all or some of the claims 12-30 or will swear behind the reference.

15) Regarding point "7." on page 6 of the Office Action: The reason given for the indication of allowable subject matter provided by the Examiner is appreciated. Thank you. However, Applicant believes such is narrower in scope as written than is necessary for allowability. It is the novel combination of elements, un-suggested by any proper combination of the prior art, and the benefits provided by such combination in each claim 1-7, 11 and 9-10, 31 which provides the reasoning for allowance. Applicant does not fully agree with the narrowness used by the Examiner in his reasons for allowance, but Applicant does agree with the Examiner's determination of allowable subject matter.

Below are Applicant's proposed reasons for allowance:

Claim 1 is allowable because of the novel combination of elements not taught and not suggested by the prior art, the novel nonobvious combination comprising an improved mouse of the type having surface-tracking pointing control, the mouse further of the type including a housing, electronic circuitry within the housing and coupled to structure communicating control signals from the electronic circuitry to a computer, a plurality of finger depressible buttons exposed on the housing and interfacing with sensors electrically

connected with the electronic circuitry; the buttons allowing user selection of control signals communicated to the computer; at least two of the sensors each capable of providing at least three readable states of varied conductance, at least two states of the at least three readable states dependent upon depressive pressure applied to the variable-conductance sensors through depression of an associated button; with the electronic circuitry reading the at least three readable states and providing a distinct control signal for each state of the at least two states, the distinct control signals are screen scrolling control signals used to determine scrolling speed rates, whereby a pointer controlled by the mouse is not required to be located on a scrolling elevator showing on a monitor.

Claim 2 is allowable because of the novel combination of elements not taught and not suggested by the prior art, the novel nonobvious combination including all of the elements of claim 1 and wherein the at least two of the sensors are analog sensors each including pressure-sensitive variable-conductance material.

Claim 3 is allowable because of the novel combination of elements not taught and not suggested by the prior art, the novel nonobvious combination comprising an improved mouse of the type having surface-tracking pointing control, the mouse further of the type including a housing, electronic circuitry within the housing and coupled to structure communicating control signals from the electronic circuitry to a computer, a plurality of finger depressible buttons exposed on the housing and interfacing with sensors electrically connected with the electronic circuitry; the buttons allowing user selection of control signals communicated to a computer; and at least two of the sensors are analog sensors

each including pressure-sensitive variable-conductance material to provide at least three readable states of varied conductance, the states dependent upon depressive pressure applied to the pressure-sensitive variable-conductance material; the electronic circuitry reading the at least three readable states and producing a distinct control signal for each of at least two states of the at least three readable states, whereby the mouse outputs the distinct control signal regardless of a pointer position on a display.

Claim 4 is allowable because of the novel combination of elements not taught and not suggested by the prior art, the novel nonobvious combination including all of the elements of claim 3 and wherein the distinct control signals are screen scrolling control signals, and are used to determine scrolling speed rates.

Claim 5 is allowable because of the novel combination of elements not taught and not suggested by the prior art, the novel nonobvious combination comprising an improved mouse of the type having surface-tracking pointing control on a display, the mouse further of the type including a housing, electrical power source powering electronic circuitry, the electronic circuitry connected to structure communicating control signals from the electronic circuitry to a computer, a plurality of finger depressible buttons exposed on the housing and interfacing with sensors electrically connected with the electronic circuitry; the buttons allowing user selection of control signals communicated to the computer; and at least two of the sensors are analog sensors including pressure-sensitive variable-conductance material, each the analog sensor structured to provide at least three readable states of varied conductance, the states dependent upon depressive pressure

applied individually to the sensors of the at least two sensors; the electronic circuitry reading the at least three readable states and producing scroll control signals representative of each of at least two states of the at least three readable states; a first sensor of the at least two sensors, the first sensor associated with a first button of the finger depressible buttons, the first button variably depressible to allow applying varied depressive pressure to the first sensor, the first sensor connected to the electronic circuitry, the electronic circuitry reading the at least three readable states and producing at least two different scroll-up values as the scroll control signals; a second sensor of the at least two sensors, the second sensor associated with a second button of the finger depressible buttons, the second button variably depressible to allow applying varied depressive pressure to the second sensor, the second sensor connected to the electronic circuitry, the electronic circuitry reading the at least three readable states and producing at least two different scroll-down values as the scroll control signals, whereby a pointer controlled by the mouse is not required to be located on a scrolling elevator showing on a display.

Claim 6 is allowable because of the novel combination of elements not taught and not suggested by the prior art, the novel nonobvious combination including all of the elements of claim 5 and wherein the first and second sensors include elastomeric dome-caps including the pressure-sensitive variable-conductance material carried by and within the dome-caps.

Claim 7 is allowable because of the novel combination of elements not taught and not suggested by the prior art, the novel nonobvious combination including all of the elements of claim 5 and wherein the first and second sensors are each packaged sensors each comprising: a package housing; an electrically conductive concavo-convex resilient disk within the package housing; two normally electrically separated proximal circuit elements at least in-part within the package housing; a depressible button retained to the package housing and positioned such that depression of the button depresses the disk; the pressure-sensitive variable-conductance material positioned within the package housing to receive compressive pressure thereagainst from and upon depression of the disk, the pressure-sensitive variable-conductance material further positioned to define at least a portion of an electrically conductive path defined between the proximal circuit elements upon depression of the disk, whereby the electrically conductive path is of varied electrical conductivity dependent upon an amount of compression applied to the pressure-sensitive variable-conductance material.

Claim 8 is allowable because of the novel combination of elements not taught and not suggested by the prior art, the novel nonobvious combination comprising a method of controlling window scrolling using a mouse having surface-tracking controlling a pointer, comprising: depressing, by a user, an analog scroll control button, located on the mouse, and controlling variable screen scrolling rate by way of selecting the pressure applied to the analog scroll control button.

Claim 9 is allowable because of the novel combination of elements not taught and not suggested by the prior art, the novel nonobvious combination including all of the elements of claim 8 and wherein the method further comprises increasing pressure applied to the analog scroll control button for increasing scrolling rate, and the pointer controlled by the mouse is not required to be located on a scrolling elevator showing on a monitor.

Claim 10 is allowable because of the novel combination of elements not taught and not suggested by the prior art, the novel nonobvious combination including all of the elements of claim 9 and wherein the method further comprises decreasing pressure applied to the analog scroll control button for decreasing scrolling rate.

Claim 11 is allowable because of the novel combination of elements not taught and not suggested by the prior art, the novel nonobvious combination comprising a method of manufacturing an improved mouse including the steps: molding a housing; installing surface-tracking pointer control; installing electronic circuitry within the housing; connecting communication structure to the electronic circuitry enabling communication from the mouse to a computer; installing a plurality of finger depressible buttons positioned to actuate sensors electrically connected with the electronic circuitry; the electronic circuitry reading a plurality of the sensors as sensors having only two readable values; and further including the novel combined steps: installing pressure-sensitive variable-conductance analog sensors positioned to be activated by depression of at least some buttons of the finger depressible buttons, the pressure-sensitive variable-

conductance analog sensors structured to provide at least three readable values, the values dependent upon depressive pressure applied to the pressure-sensitive variable-conductance analog sensors; installing circuitry reading an immediate value of the at least three readable values of the pressure-sensitive variable-conductance analog sensors, and communicating data representative of the immediate value from the mouse to a computer, whereby the mouse is manufactured for communicating data representative of the depressive pressure applied to the pressure-sensitive variable-conductance analog sensors regardless of the position of a pointer controlled by the mouse.

Claim 31 is allowable because of the novel combination of elements not taught and not suggested by the prior art, the novel nonobvious combination comprising a device controlling a pointer or cursor shown in a display, comprising: a housing shaped to be held by a human hand, the housing substantially movable across a surface adjacent to the housing, movement of the housing relative to the surface controls movement of the pointer or cursor in the display, the housing supporting two finger depressible buttons positioned to actuate two On/Off switches, the housing further supporting at least one finger pressible element positioned to actuate at least two pressure-sensitive variable sensors, output from the variable sensors variably controls scrolling within the display.

16) In view of this response and all reference art please reexamine the claims, again finding claims 1-7 and 11 allowable and additionally finding claims 8-10 and 31 also allowable in view of the above.

Assistance from the Examiner regarding claims 12-30 would be appreciated.

Again, the Examiner is thanked for his assistance with this very important matter, and is invited to contact Applicant if Applicant might be of any help.

Very Respectfully,

Signature: Brad A Armstrong Date: 6-30-04

Brad A. Armstrong, Inventor / Applicant

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